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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212004
Party	Defendant Xingtang Ren
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of:
Application Serial No. 85/755,945
Published in the *Official Gazette*
April 16, 2013

PRL USA HOLDINGS, INC.,)	
Opposer,)	
)	
v.)	Opposition No. 91212004
)	
XINGTANG REN,)	
Applicant.)	

**ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM TO CANCEL
OPPOSER'S TRADEMARK REGISTRATION**

Applicant, Xingtang Ren of GBR POLO LIMITED, for his answer to the Notice of Opposition (the "Notice") filed by PRL USA Holding, Inc ("Opposer") against application for registration of his trademark GBR POLO, serial No. 85/755,945 filed October 17, 2012, and published in the Official Gazette of April 16, 2013, pleads and avers as follows:

1. Answering paragraphs 1-3 of the Notice, Applicant admits the alleged facts thereof to the extent that it is relevant and material to this proceeding.

1a. Answering paragraphs 4 of the Notice, Applicant denies the alleged facts thereof. Applicant's mark has been used in commerce outside the United States.

2. Answering paragraph 5-8 of the Notice, Applicant does not have sufficient knowledge or information to form a belief as to the truth of the alleged facts contained therein but would stipulate the alleged facts.

3. Answering paragraph 9 of the Notice, Applicant denies the alleged facts thereof.

Upon information and belief, Opposer has not extensively used “POLO” as trademark in commerce.

4. Answering paragraph 10 of the Notice, Applicant denies the alleged facts thereof.

Upon information and belief, “POLO” is not synonymous with any business entity. As a noun it refers to a “team sport played on horseback in which the objective is to score goals against an opposing team” (see <http://en.wikipedia.org/wiki/Polo>). As an adjective or a noun in the relevant market, it has also become a generic term referring to a type of clothing as evidenced below:

Polo shirt - Wikipedia, the free encyclopedia

en.wikipedia.org/wiki/Polo_shirt

A **polo shirt**, also known as a **golf shirt** and **tennis shirt**, is a T-shaped shirt with a collar, a placket with typically two or three buttons, and an optional pocket.

5. Answering paragraph 11 of the Notice, Applicant denies the allegations thereof.

Upon information and belief, Opposer has not extensively used “POLO” as trademark in commerce, notwithstanding that Opposer may have used extensively some other trademarks that contain the word “polo” therein.

5. Answering paragraphs 12 of the Notice, Applicant denies the allegations thereof to the extent that they imply that all trademark registrations listed in Exhibit A are the “POLO” Mark.

6. Answering paragraph 13 of the Notice, Applicant denies the allegations thereof to the extent that they imply that all trademark registrations listed in Exhibit B are the “POLO” Mark.

7. Answering paragraph 14 of the Notice, Applicant does not have sufficient knowledge or information to form a belief as to the truth of the alleged facts contained therein and accordingly denies the allegations.

8. Answering paragraph 15 of the Notice, Applicant does not have sufficient knowledge or information to form a belief as to the truth of the alleged facts contained therein but would stipulate the alleged facts.

8. Answering paragraph 16 of the Notice, Applicant denies the allegations thereof. Upon information and belief, Opposer has not extensively used "POLO" as trademark on its goods, notwithstanding that Opposer may have used extensively some other trademarks that contain the word "polo" therein.

9. Answering paragraph 17 of the Notice, Applicant does not have sufficient knowledge or information to form a belief as to the truth of the alleged facts contained therein and accordingly denies the allegations.

10. Answering paragraph 18-19 of the Notice, Applicant denies the allegations thereof. Upon information and belief, Opposer has not extensively used "POLO" as trademark in commerce, notwithstanding that Opposer may have used extensively some other trademarks that contain the word "polo" therein.

10. Answering count I of the Notice, Applicant denies the allegations thereof.

11. Answering paragraph 21, Applicant denies the alleged facts thereof, Upon information and belief, "POLO" is neither a famous trademark in the U.S. nor in the world, notwithstanding that there may be well-known trademarks that contain, among other more dominant elements, the word "polo" therein.

12. Answering paragraph 22, Applicant does not have sufficient knowledge or information to form a belief as to the truth of the alleged facts contained therein and accordingly denies the allegations.

13. Answering paragraph 23, Applicant denied the alleged facts thereof because Applicant's mark "GBR POLO" is different from the mark "POLO" in sight, sound and overall commercial impression.

14. Answering paragraphs 24 of the Notice, Applicant admits the alleged facts thereof but only in the sense that the mark "GBR POLO" contains the word "POLO" and Applicant's registration disclaimed the "POLO" word.

15. Answering paragraph 25, Applicant does not have sufficient knowledge or information to form a belief as the allegations contained therein and accordingly denies the allegation.

16. Answering paragraph 26, Applicant admits the alleged facts thereof.

17. Answering paragraph 27, Applicant denied the allegations thereof because numerous registered marks containing the exactly same "POLO" word are presently owned by various different owners who, upon information and belief, are not in any way affiliated with Opposer.

18. Answering count II of the Notice, Applicant denies the allegations thereof.

19. Answering paragraph 28, Applicant denied the allegations repeated thereof unless Applicant has explicitly admitted.

20. Answering paragraph 29-33, Applicant denies the allegations thereof. Upon information and belief, "POLO" is not a famous trademark, notwithstanding that there may be famous trademarks that contain, among other more dominant elements, the word "polo" therein.

22. Answering count III of the Notice, Applicant denies the allegations thereof.
23. Answering paragraph 34, Applicant denied the allegations repeated therein unless Applicant has explicitly admitted.
24. Answering paragraphs 35-36, Applicant denied the allegations thereof. The Applicant's mark has been used elsewhere and is intended to be used in the U.S.

AFFIRMATIVE DEFENSES

First Affirmative Defense

25. Applicant's mark differs in terms of sight, sound and impression from any of the Opposer's marks cited in the Notice.

Second Affirmative Defense

26. The word "polo" by itself is a descriptive term with no acquired distinctiveness and thus cannot as a matter of law form the basis for a dilution claim.

Third Affirmative Defense

27. The word "POLO" is contained in numerous registered marks in the U.S. not owned by Opposer, such as DRA. ANA MARIA POLO (433637), CHEVAL POLO (414887), HIDDEN CREEK POLO (352657), POWER 3 POLO (329234), GIANCO POLO (356425), JON POLO (3292597), U.S. POLO ASSN., (2908391), TEXAS POLO (2835902), POLO LOUNGE (1718989), POLO LIFE (1710894), etc. Therefore, the registration of those marks bars any likelihood of confusion or dilution claims by Opposer.

Fourth Affirmative Defense

28. Opposer's claim of trademark dilution is barred because Applicant's mark is substantially different from any of the Opposer's alleged marks.

Fifth Affirmative Defense

29. Opposer's claim of trademark dilution is barred because the marks containing "POLO" are associated with a large number of different business entities and thus Opposer is not engaging in substantially exclusive use of the marks containing the word "POLO".

Sixth Affirmative Defense

30. Opposer's claim of likelihood of confusion or dilution is barred because Opposer has not engaged in *bona fide* use of the "POLO" mark or has abandoned the "POLO" mark.

Seventh Affirmative Defense

30. Opposer's claim of likelihood of confusion or dilution is barred because Opposer has committed inequitable conduct in the process of renewing registration of the "POLO" mark by knowingly submitting a specimen that bears a mark that is not the subject mark of renewal and thus is a piece of false evidence in support the use of the mark.

COUNTERCLAIM TO CANCEL OPPOSER'S REGISTERED "POLO" MARK

FIRST CLAIM FOR CANCELLATION (NON-USE)

31. Upon information and belief, Applicant alleges that Opposer has not engaged in *bona fide* use of the registered "POLO" mark (Under Registration Nos. 276855, 1363459 and 1468420) or has abandoned the mark.

32. In the most recent registration renewal of the "POLO" mark (Under Registration Nos. 276855, 1363459 and 1468420), the Opposer has submitted a specimen which bears a mark that is not the subject mark of the renewed registration.

33. The registered mark "POLO" under registration number 276855 is not the same mark under registration number 978166 also owned by Opposer, which has more dominant and distinctive graphic design elements as follows:



34. Accordingly, the use of the mark under registration number 978166 shown above cannot be used as evidence of the use of the word mark "POLO" under registration number 276855.

35. However, when submitting the specimen in supporting its claim of use of the word mark "POLO" under registration number 276855, Opposer knowingly submitted a

specimen bearing the mark under registration number 978166. The two marks are substantially different.

36. The registered mark “POLO” under registration number 1363459 is not the same mark under registration number 978166 which is also owned by Opposer.

37. Accordingly, the use of the mark under registration number 978166 cannot be used as evidence of the use of the word mark “POLO” under registration number 1363459.

38. However, when submitting the specimen in supporting its claim of use of the word mark “POLO” under registration number 1363459, Opposer knowingly submitted a specimen bearing the mark under registration number 978166 as shown below:



39. The registered word mark “POLO” under registration number 1468420 is not the same mark as shown below:



40. Accordingly, the use of the above mark in a specimen cannot be used as the evidence of use of the mark “POLO” under registration number 1468420, which is a word mark containing the lone word “POLO” without any graphic design elements.

41. However, when submitting the evidence in supporting its claim of use of the “POLO” mark under registration number 1468420 for renewal, Opposer submitted a specimen bearing a different mark (shown above) with predominantly graphic design elements.

42. From Opposer's online store, <http://www.ralphlauren.com>, Applicant did not find any goods bearing the "POLO" mark under registration numbers 276855, 1363459 and 1468420.

SECOND CLAIM FOR CANCELLATION (INEQUITABLE CONDUCT)

42. Applicant repeats and realleges, each and every allegation contained in the foregoing paragraphs.

43. Opposer knowingly claimed the use of the "POLO" mark under registration No. 276855 in the most recent renewal process with false evidence.

44. Opposer knowingly submitted a specimen which could not support its use claim required for renewal of the "POLO" mark under registration No. 276855 because the specimen clearly showed a vastly different mark.

45. Opposer knowingly claimed the use of the "POLO" mark under registration No. 1363459 in the most recent renewal process with false evidence.

46. Opposer knowingly submitted a specimen which could not support its use claim required for renewal of the "POLO" mark under registration No. 1363459 because the specimen clearly showed a vastly different mark.

47. Opposer knowingly claimed the use of the "POLO" mark under registration No. 1468420 in the most recent renewal process with false evidence.

48. Opposer knowingly submitted a specimen which could not support its use claim required for renewal of the "POLO" mark under registration No. 1468420 because the specimen clearly showed a vastly different mark.

THIRD CLAIM FOR CANCELLATION (GENERIC TERM)

49. The word "POLO" by itself has become a generic term referring to a certain type of clothing articles.

50. Polos are sold by many different designers and sources, such as Lacoste, Fred Perry, Hanes, Asos, Hifiger, Hackett, Replay, Teb Baker, Crew, Lyle & Scott, Scotch & Soda, Joules Woody, Merc, Old Navy, and numerous other sources.

51. Just like the generic terms "Aspirin" and "Thermos", the term "Polo" has become a generic term and its registration as a trademark shall be cancelled.

WHEREFORE, Applicant prays:

1. That Opposer's Opposition be dismissed with prejudice;
2. That Applicant Serial No. 85/755,945 be allowed to proceed to registration.
3. That Opposer's "POLO" mark under registration numbers 276855, 1363459 and 1468420 be cancelled.

Respectfully submitted,

Dated: September 20, 2013

/George G. Wang/

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CERTIFICATE OF SERVICE

I hereby certify that on September 20, 2013, a copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM TO CANCEL OPPOSER'S TRADEMARK REGISTRATION** was served upon the correspondent of record for Opposer in the following manner:

1. Via email to: schlossd@gtlaw.com, kertzers@gtlaw.com
2. Via Express Mail, postage prepaid, to the following address:
Daniel I. Schloss
Seth E. Kertzer
200 Park Avenue
New York, New York 10166
U.S.A.
(212) 801-9200, (212) 801-6400

/George G. Wang/
George G. Wang